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JUL 31 1985

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[Serial No. 541,489 10/13/83]
Ole K. Nilssen

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Before the Board of Appeals

Ole K. Nilssen
For Appellant

Examiner's Answer

This is an appeal from the final rejection of
claims 48 to 51. Claim 45 is allowable.

A correct copy of the claims on appeal appears as
an attachment to the appellant's brief.

REFERENCES OF RECORD RELIED ON:

| | | |
|-----------|---------|--------|
| 4,008,414 | Agnew | 2/1977 |
| 4,184,128 | Nilssen | 1/1980 |

STATEMENT OF THE GROUNDS OF REJECTION

Claims 48 to 51 are rejected under 35 U.S.C. 103 as
being unpatentable over Nilssen in view of Agnew.

An accurate description of the invention appears on page 1 of appellant's brief. Nilssen discloses in figure 8 all the elements of the claimed invention except for the inverter disabling means. Agnew teaches the concept of connecting the cathode filaments of a discharge lamp in series circuit with the feedback loop of its associated oscillator such that upon removal of the lamp, the oscillator is inhibited from operating.

Thus one of ordinary skill in the art would be led by the teaching of Agnew to connect the cathode filaments of a discharge lamp load in circuit with the feedback loop of the circuit of Nilssen figure 8. Appellant agrees that this combination is obvious to one of ordinary skill in the art, as evidenced by the cancellation of all claims directed to this subject matter in the response of December 24, 1984, paper No. 11. It is the Examiner's position that upon making the proposed combination, one skilled in the art would place the trigger pulse circuit in the cathode filament circuit, to similarly disable the production of trigger pulses in the condition where no load is connected to the output of the inverter, to attain the claimed invention.

RESPONSE TO ARGUMENTS IN THE BRIEF

Appellant argues that Agnew's inverter is not of the type that is triggered into operation. The significance of this argument is not understood since Appellant has conceded the obviousness of the proposed combination. The only point of contention is the

obviousness of disabling trigger pulse production upon lamp removal. Appellant's argument that connecting resistor 213 to point 210 would double the power dissipation in the resistor (and presumably would therefore not be made) is similarly not understood since such a modification was never proposed. Referring to figure 8 of Nilssen, the top of resistor 213 is connected to the left side of transformer 207. Thus, simply shortening the length of wire therebetween so that a cathode filament comes between capacitor 204 and resistor 213 would achieve an inhibition of trigger pulses upon lamp removal.

Appellant argues that the fact that trigger pulse production is useless if there is no load connected to the output, is irrelevant. The Examiner's position is that such a fact presents a significant design consideration to one of ordinary skill in the art. Clearly, good engineering practice dictates against useless power dissipation whenever it can be avoided. Therefore, upon following the teaching of Agnew, one skilled in the art would recognize that the production of trigger pulses when no load is present is both useless and avoidable. Thus, it is obvious to disable trigger pulse production upon lamp removal to attain the claimed invention.

Appellant's arguments regarding MPEP 706.02 should be dismissed since they are not directed to the merits of the claims on appeal and thus do not present an

appealable issue to the Board.

Finally, if the prior art suggests a combination of references to one skilled in the art that attains the claimed invention, appellant's particular motivation for making the same combination does not enter into a determination of patentability.

CONCLUSION

For all the foregoing reasons, the rejection of claims 48 to 51 is deemed proper and affirmance thereof is requested.

Respectfully submitted,

DL

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7-29-85

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